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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/029,656	12/21/2001	Clive Patience	329579-3	5770

7590 02/25/2003

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EXAMINER

FOLEY, SHANON A

ART UNIT	PAPER NUMBER
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1648

DATE MAILED: 02/25/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/029,656

Applicant(s)

PATIENCE ET AL.

Examiner

Shanon Foley

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 December 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-51 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-51 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- ☐ Interview Summary (PTO-413) Paper No(s). _____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-3 and 12-14, drawn to a nucleic acid encoding SEQ ID NO: 15, classified in class 536, subclass 23.1.
- II. Claims 4 and 12-14, drawn to a nucleic acid encoding SEQ ID NO: 11, classified in class 536, subclass 23.1.
- III. Claim 4 and 12-14, drawn to nucleic acid encoding SEQ ID NO: 13, classified in class 536, subclass 23.1.
- IV. Claims 5-7 and 15-17, drawn to a polypeptide encoding SEQ ID NO: 16, classified in class 530, subclass 350.
- V. Claim 7, drawn to an isolated polypeptide comprising SEQ ID NO: 12, classified in class 530, subclass 350.
- VI. Claim 7, drawn to an isolated polypeptide comprising SEQ ID NO: 14, classified in class 530, subclass 350.
- VII. Claim 7, drawn to an isolated polypeptide comprising SEQ ID NO: 17, classified in class 530, subclass 350.
- VIII. Claims 8, 9 and 11, drawn to an antibody that reacts with a PERV receptor, classified in class 530, subclass 387.1.
- IX. Claim 10, drawn to an antibody that reacts specifically with SEQ ID NO: 10, classified in class 536, subclass 387.9.

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- X. Claim 10, drawn to an antibody that reacts specifically with SEQ ID NO: 12, classified in class 536, subclass 387.9.
- XI. Claim 10, drawn to an antibody that reacts specifically with SEQ ID NO: 14, classified in class 536, subclass 387.9.
- XII. Claim 10, drawn to an antibody that reacts specifically with SEQ ID NO: 16, classified in class 536, subclass 387.9.
- XIII. Claim 10, drawn to an antibody that reacts specifically with SEQ ID NO: 17, classified in class 536, subclass 387.9.
- XIV. Claims 18-25, drawn to a method of identifying a compound that interferes with PERV-binding to a cell by contacting a compound with a PERV receptor, classified in class 435, subclass 32.

If applicant elects this group, applicant must also elect one amino acid SEQ ID NO: 10 or 12 or 14 or 16 or 17, as each are drawn to patentably distinct inventions.

Once applicant has elected a specific amino acid SEQ ID NO., applicant must also elect a specific nucleic acid SEQ ID NO: 11 or 13 or 15, as each are drawn to patentably distinct inventions.

- XV. Claims 26 and 27, drawn to a process to detect the presence of a PERV binding site on a cell by contacting the cell with an antibody, classified in class 435, subclass 7.1.
- XVI. Claims 28-32, drawn to a process of identifying the presence of a PERV-receptor gene in a cell genome with a probe, classified in class 436, subclass 508 and class 536, subclass 24.3.

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If applicant elects this group, applicant is further required to elect a specific SEQ ID NO:

11 or 13 or 15, as each are drawn to patentably distinct inventions.

XVII. Claims 33-38, drawn to a process for blocking a PERV receptor on a cell by contacting the receptor with an agent, classified in class 435, subclass 7.2.

If applicant elects this group, applicant is further required to elect a specific SEQ ID NO:

10 or 12 or 14 or 16, as each are drawn to patentably distinct inventions.

XVIII. Claims 39-44, drawn to a method of protecting against PERV infection, classified in class 424, subclass 184.1.

If applicant elects this group, applicant is further required to elect a specific SEQ ID NO:

10 or 12 or 14 or 16 or 17, as each are drawn to patentably distinct inventions.

XIX. Claim 45, drawn to a method of making a product by identifying an agent, classified in class 435, subclass 4.

XX. Claims 46-49, drawn to a transgenic animal, classified in class 435, subclass 410.

If applicant elects this group, applicant is further required to elect a specific SEQ ID NO:

12 or 14 or 16, as each are drawn to patentably distinct inventions.

XXI. Claims 50 and 51, drawn to a process of identifying a compound that protects against PERV infection by administering a compound to a transgenic animal, classified in class 424, subclass 9.2.

The inventions are distinct, each from the other because of the following reasons:

Inventions I-III are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different

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inventions functionally different because the nucleic acid sequences encode different products are each group possesses distinctly different structural components. These structural differences among the sequences require separate fields of search, as evidenced by their separately designated SEQ ID NO.

Inventions IV-VII are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions encode different receptor products that interact with different receptor binding agents and molecules. Also, there are unique structural differences between the sequences which require separate fields of search, as evidenced by their separately designated SEQ ID NO.

Inventions VIII-XIII are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are drawn to structurally distinct antibodies that react with different cellular receptors. The antibodies of group VIII are required to react generically with any PERV receptor, while the antibodies of groups IX-XIII only react with specific amino acid sequences and no other. Each of the instant antibodies require separate fields of search due to their unique binding properties.

Inventions I-III and IV-VII and IX-XIII are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are separately classified and having separate fields of search.

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In addition, the polypeptides do not require the nucleic acid that encodes them and can be made synthetically. Each of the instant products are structurally and functionally unrelated.

Inventions I-III, IV-VII and XIV are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the instant process can be used with any of the structurally distinct receptor products claimed in groups I-III, IV-VII.

Inventions VIII-XIII and XV are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the process of group XV can be practiced with any of the antibodies of groups VIII-XIII.

Inventions I-III and XVI are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the process can be completed with any of the patentably distinct sequences of groups I-III or fragments thereof.

Inventions IV-VII, VIII-XIII and XVII are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the

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process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the process claimed can be accomplished with any receptor claimed in claims IV-VII, and with any antibody of groups VIII-XIII or any agent bearing no structural or functional similarity to the instant antibodies.

Inventions VIII-XIII and XVIII are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the process of protecting against ERV infection can be practiced with any agent that binds to various PERV receptors or any specific antibody claimed in groups VIII-XIII.

Inventions VIII-XIII and XIX are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the method of making the product could be identifying any of the instant antibodies claimed in groups VIII-XIII or any agent that does share any resemblance to the instant antibodies.

Inventions I-XIII and XX are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case,

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group XX is drawn to a transgenic animal that is structurally and functionally distinct from the nucleic acids, polypeptides, and antibodies of groups I-III, IV-VII and VIII-XIII, respectively.

Inventions XIX and XXI are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions require distinct method steps and ingredients and are classified separately.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification and divergent subject matter, restriction for examination purposes as indicated is proper.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shanon Foley whose telephone number is (703) 308-3983. The examiner can normally be reached on M-F 9:00-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Housel can be reached on (703) 308-4027. The fax phone numbers for the


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organization where this application or proceeding is assigned are (703) 308-4242 for regular communications and (703) 308-4426 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.


Shanon Foley
February 15, 2003


JAMES HOUSEL 2/23/03
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600